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23696 7590 09/29/2009 QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHIDAMBARAM KRISHNAN,
JAMES A. HUTCHISON IV, and TOM SUMMERS

Appeal 2008-004906
Application 09/867,363
Technology Center 2400

Decided: September 25, 2009

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-49, 52-57, 60-65, and 68-105, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Representative Claim

1. A method for managing power to a subscriber identity module (SIM) in a wireless communication device (WCD) when power is supplied to the WCD during operation of the WCD, the method comprising:

supplying power to the SIM when a request is pending for service by the SIM;

supplying power to the SIM when a software module running on the WCD requests maintenance of power to the SIM; and

terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM.

Prior Art

Thakker	US 6,487,425 B1	Nov. 26, 2002
Eber	US 6,595,414 B1	Jul. 22, 2003
Timonen	US 6,741,848 B2	May 25, 2004
Barvesten	EP 0 607 767 A1	Jul. 27, 1994

Examiner's Rejections

Claims 1-5, 7-9, 16-21, 23-25, 32-37, 39-41, 48, 74-78, 80-82, 89-94, 96-98, and 105 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Thakker.

Claims 6, 22, 38, 79, and 95 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thakker and Timonen.

Claims 10, 26, 42, 83, and 99 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thakker and Eber.

Claims 11-13, 27-29, 43-45, 84-86, and 100-102 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thakker and Barvesten.

Claims 14, 15, 30, 31, 46, 47, 87, 88, 103, and 104 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thakker, Barvesten, and Timonen.

Claims 49, 52, 53, 55-57, 60, 61, 63-65, 68, 69, and 71-73 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thakker and Barvesten.

Claims 54, 62, and 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thakker, Barvesten, and Timonen.

ISSUE

Have Appellants shown the Examiner erred in finding that Thakker discloses terminating power to a subscriber identity module (SIM) when no request is pending for service by the SIM and no software module running on the wireless communication device requests maintenance of power to the SIM?

FINDINGS OF FACT

1. Thakker discloses a mobile station (MS) 12 that usually includes a mobile transceiver and a SIM. The SIM may include an identity indicator (a “secret” key for authentication), and other relevant network/user information. Figs. 1 and 2; col. 5, ll. 28-32.

2. Thakker also discloses that once the Global System for Mobile (GSM) network 40 has sent a power-on-page (POP) mode acknowledgment message (at signal sequence 94) to the mobile station (MS) 50, the MS 50 will remain in the limited operations low power mode, listening only for POP messages from the GSM network 40. While in POP mode, the MS 50 operates using minimal power where, for example, only critical operations are maintained, the display is blank, and no outgoing calls are made unless POP mode is disabled. Regardless of the amount of power utilized by the MS 50 during limited operations low power, the MS 50 continues to perform a few critical functions. For example, the MS 50 is responsible to inform the network 40 of its location as illustrated by the location update request signal sequence 96. Thus, the MS 50 powers up periodically in order to ascertain its location and update the network 40. This positioning is performed by allowing the MS 50 to send a LOCATION UPDATE REQUEST message to the GSM network 40. The GSM network 40, in turn, sends a LOCATION UPDATING ACCEPT message at signal sequence 98, to the MS 50. By continuously updating the location of the MS 50 in the GSM network 40, a subscriber may be reached, even while the MS 50 is in POP mode. Col. 7, ll. 42-64.

PRINCIPLES OF LAW

Prima Facie Case of Unpatentability

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of

presenting a prima facie case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

ANALYSIS

Claim 1 recites “terminating power to the SIM when no request is pending for service by the SIM and no software module running on the WCD requests maintenance of power to the SIM.” The Examiner finds that Thakker discloses this limitation at column 7, lines 42 through 64 (Ans. 4). That section of Thakker discloses a low power mode for a mobile station (MS) (FF 2). Appellants contend that this portion of Thakker does not describe “terminating power to the SIM” as recited in claim 1 (Br. 13).

In response, the Examiner finds that “while in POP (Power on Page) mode, the MS has terminated power (i.e. minimal) power where only critical

operations are maintained and the display is blank and no outgoing calls are made unless POP mode is disabled [column 7, lines 46-50]. As discussed above, a call to the MSISDN number associated with the limited operations low power mode of the MS 50 causes the MS 50 to switch to normal operating mode” (Ans. 15).

First, we observe that the Examiner has not pointed to any special definition in the Specification to indicate that “terminating” might include “minimizing” power, or something other than the absence of power.

Further, while we agree that Thakker discloses a “low power” mode, we do not find adequate support in Thakker for a finding that, in such a mode, power to the SIM is terminated. The section of Thakker on which the rejection relies simply does not provide sufficient detail of how power might be distributed to the mobile station components to support a conclusion that power to the SIM is terminated during the low power mode.¹

The Examiner also errs in relying on the material in column 7 of Thakker to show similar limitations recited in independent claims 17, 33, 49, 57, 65, 74, and 90 (Ans 3-4, 10).

Independent claims 49, 57, and 65, which recite limitations similar to those of claim 1 with respect to terminating power to the SIM, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Thakker and Barvesten. Barvesten does not remedy the deficiencies of Thakker.

¹ Moreover, the reference appears to suggest otherwise. The SIM likely receives power during the mobile station’s low power mode, because the identity indicator and other relevant network/user information is stored in the SIM (FF 1), which would be required information for critical functions that continue during the low power mode (*see* FF 2).

Because we are persuaded that the rejections fail because of the speculative basis for the Examiner's findings with respect to Thakker, we cannot sustain the rejections of claims 1-49, 52-57, 60-65, and 68-105.

CONCLUSION OF LAW

Appellants have shown the Examiner erred in finding that Thakker discloses terminating power to a subscriber identity module (SIM) when no request is pending for service by the SIM and no software module running on the wireless communication device requests maintenance of power to the SIM.

DECISION

The rejection of claims 1-49, 52-57, 60-65, and 68-105 under 35 U.S.C. § 102 or 103 is reversed.

REVERSED

msc

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